

REMARKS

Applicants respectfully request entry of the foregoing and reconsideration of the subject matter identified in caption, as amended, pursuant to and consistent with 37 C.F.R. § 1.112, and in light of the remarks which follow.

Applicants thank the Examiner for withdrawing the § 103(a) rejection over Bailey in view of Applicants' Amendment originally filed on September 24, 2004, and later entered with Applicants' Request for Continued Examination (RCE) on November 23, 2004.

Claims 23, 29-33, 37-40, 42, 48 and 49 are pending in the application, new Claim 49 having been added above.

By the above amendments, Claims 37 and 38 are amended to address a § 112 issue. Applicants have amended Claims 37 and 38 to clarify the claims so that they are more consistent with the language of Claim 48. Because these amendments do not narrow the scope of the claims, the claims should be accorded their full range of equivalents.

Turning now to the Official Action, Claims 37 and 38 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. Applicants have amended Claims 37 and 38 to obviate the rejection. In particular, Applicants have amended Claims 37 and 38 to make the claims more consistent with independent Claim 48. Additionally, Applicants have deleted the word "using" from Claim 37.

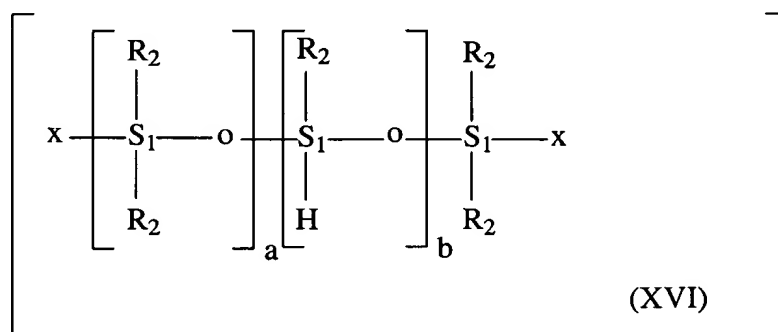
Applicants respectfully request reconsideration and withdraw of the § 112, second paragraph, rejection of Claims 37 and 38.

Claims 29-32, 37-40 and 48 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ona (U.S. Patent No. 4,366,001) in view of Bailey (U.S. Patent

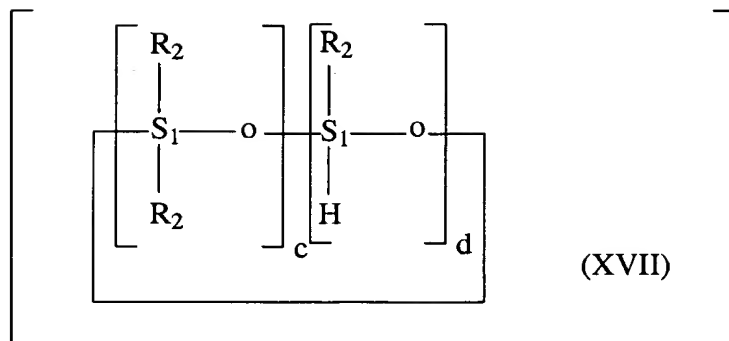
No. 2,970,150). For at least the reasons that follow, withdraw of the rejection is in order.

Claim 48 recites Process for the preparation of a nonturbid, functionalized silicone oil of stable viscosity, the process comprising: hydrosilylating polyorganohydrosiloxane with synthons wherein:

- (1) the synthons hydrosilylated with the polyorganohydrosiloxane are different or identical, comprising at least one hydrocarbon-comprising ring in which is included at least one oxygen atom,
- (2) said hydrosilylation reaction is carried out in the presence of a heterogeneous catalytic composition to reduce reactions that can form a gum and/or resin during devolatilization, the heterogeneous catalytic composition comprising a metal selected from the group consisting of cobalt, rhodium, ruthenium, platinum and nickel deposited on an inert support, said inert support selected from the group consisting of carbon black, charcoal, alumina, silicate and barium oxide, and
- (3) the polyorganohydrosiloxane is linear or cyclic and has the mean formulae:



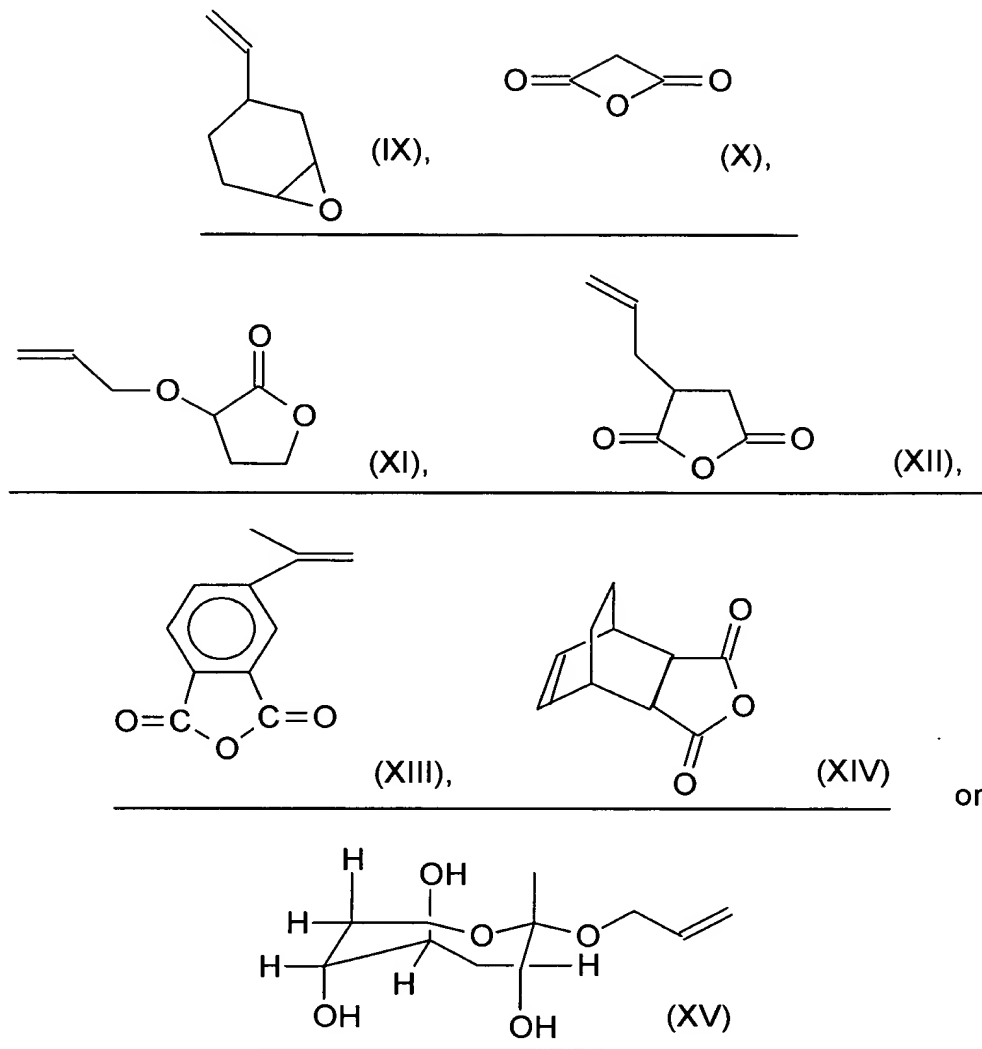
and/or



in which:

- the symbols R_2 are identical or different and correspond to a monovalent hydrocarbon-comprising radical chosen from the phenyl radical and linear or branched alkyl radicals having from 1 to 6 carbon atoms;
- the symbols x are identical or different and correspond to a monovalent radical chosen from R_2 , a hydrogen atom, a methoxy radical and an ethoxy radical;
- a and b are integers or fractions, such that:
 - $0 < a \leq 200$,
 - $0 \leq b < 200$,
 - and at least one of the two x groups corresponds to the hydrogen radical if $b = 0$,
 - $5 < a + b \leq 200$;
- c and d are integers or fractions, such that:
 - $0 < c < 5$,
 - $1 < d < 10$,
 - $3 < c + d < 10$

wherein the synthon has the formula:



; and

(4) devolatilizing a silicone oil obtained from the hydrosilylation reaction.

(Emphasis added.)

The Official Action asserts that Ona teaches epoxy siloxanes and that the epoxy siloxanes can be prepared by the reaction specified in Bailey. Additionally,

the Official Action asserts that Bailey teaches preparing silicone oils by hydrosilylating in the presence of a heterogeneous catalyst comprising platinum on an inert charcoal or alumina support. In view of these teachings, the Official Action concludes that one of ordinary skill in the art would have been motivated to select a synthon corresponding to (IX) in Claim 48 from among the many possible synthons disclosed in Ona to react with polyorganohydrosiloxane in the presence of a platinum catalyst supported on charcoal or alumina to form the epoxy siloxane in Ona. (See Official Action at pages 2-3.)

To establish a *prima facie* case of obviousness, the prior art references (or references when combined) must teach or suggest all of the claim features. See In re Royka, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). In addition, "all words in a claim must be considered in judging the patentability of that claim against the prior art." See In re Wilson, 424 F.2d 1382, 1385; 165 U.S.P.Q. 494, 496 (CCPA 1970). See MPEP § 2143.03.

Applicants submit that the asserted combination of Ona in view of Bailey does not disclose or suggest all of the features of Claim 48. That is, the asserted combination does not disclose or fairly suggest a process for the preparation of a nonturbid, functionalized silicone oil of stable viscosity, comprising hydrosilylating polyorganohydrosiloxane with synthons having the chemical formulae (IX), (X), (XI), (XII), (XIII), (XIV) or (XV) and devolatilizing a silicone oil obtained from the hydrosilylation reaction, as claimed. (Emphasis added.) Because the asserted combination fails to teach or suggest these claim features, the asserted combination fails to establish a *prima facie* case of obviousness.

In addition, the rejection over the asserted combination fails to reflect a proper consideration of “all words” in Claim 48. Specifically, because the asserted combination does not disclose or suggest a process that includes hydrosilylating polyorganohydrosiloxane with the synthons specified in Claim 48, and devolatilizing a silicone oil obtained from the hydrosilylation reaction, Applicants submit that the rejection does not give full consideration to all claim features, i.e., patentable weight must be given to the specific synthons recited and the words “devolatilizing a silicone oil obtained from the hydrosilylation reaction,” in Claim 48 in judging the patentability of the claim over the asserted combination.

Additionally, Applicants submit that the rejection over the asserted combination fails to consider the invention as a whole. In particular, the asserted combination does not disclose or fairly suggest a process that includes hydrosilylating polyorganohydrosiloxane with synthons having the specified formulae recited in Claim 48, and devolatilizing a silicone oil obtained from the hydrosilylation reaction to prepare a nonturbid, functionalized silicone oil of stable viscosity. (Emphasis added.) Because the asserted combination fails to consider the problem of producing a nonturbid, functionalized silicone oil of stable viscosity, Applicants submit that the process of Claim 48 would not have been obvious over the asserted combination for at least this additional reason.

Furthermore, in establishing a *prima facie* case of obviousness under 35 U.S.C. §103, it is incumbent upon the Patent Office to provide reasons *why* one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. To this end, the requisite motivation must stem from some teaching, suggestion of inference in the

prior art as a whole or from the general knowledge available to one of ordinary skill in the art and not Applicants' disclosure. See Ex parte Nesbit, 25 USPQ2d 1817, 1819 (BPAI 1992); In re Oetiker, 24 USPQ2d 1443, 1446 (Fed. Cir. 1992). The mere fact that the prior art can be modified does not make such a modification obvious unless the prior art suggests the desirability of the modification. See In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984). There must be some intrinsic basis in the prior art or some extrinsic factor that would prompt one of ordinary skill in the art to combine the teachings of the references; otherwise, the Patent Office's burden of establishing a *prima facie* case of obviousness has not been met. Moreover, the determination of whether some reason, suggestion, or motivation existed for making the combination must be made from the viewpoint of the hypothetical person of ordinary skill in the field of the invention. In re Oetiker, *Id.* at 1446 (Fed. Cir. 1992); In re Raines, 28 USPQ2d 1630, 1631 (Fed. Cir. 1993).

In the present case, the Official Action points to one possible organopolysiloxane component of many disclosed in Ona and argues that it would have been obvious to select specific variables among many disclosed in Ona and to produce that component using a specific reaction among many disclosed in Bailey. Neither of the cited references, alone or in combination, provide motivation for making the particular selection of specific components and variables among the many disclosed in Ona and selecting a specific preparation process from among the many disclosed in Bailey to arrive at the claimed process. That is, nowhere does Ona or Bailey disclose or suggest selecting the specific component, variables and process from the cited references to obtain a process for preparing a non-turbid, functionalized silicone oil of stable viscosity, as claimed. Instead, it appears that the

references are substantially unrelated to one another or the claimed subject matter. For example, Ona relates to fiber-treating compositions to impart antistatic, moisture/perspiration absorbability, stain resistance, pliability, smoothness, crease resistance and compression recovery to fiber materials, and Bailey discloses unrelated processes for the production of organosilicone compounds.

Moreover, the Official Action continues to rely heavily on the disclosure of Example 15 of Bailey. However, Applicants have previously noted that Example 15 describes preparation of a silane. (Emphasis added.) Because Example 15 is directed to the preparation of a silane, the Example cannot be relied on to support an obviousness rejection because it is well known that a silane cannot be compared to a silicone or polyorganosiloxane oil. Furthermore, as previously pointed out, Example 15 is the only Example in Bailey that deals with epoxy species. The presently pending set of claims, however, includes a definition of $a + b > 5$, which excludes silanes. This is further emphasized by Table VI, which summarizes all of the Examples, and indicates that only one of the Examples of Bailey deals with an epoxy species, which is, of course, a silane.

In view of the varied teachings of Ona and Bailey, Applicants submit that there is no suggestion that one should, or even could, make a particular selection of components and variables from the disclosure of many possible components and variables and combine the particular components and variables with a specific, non-analogous process from among many disclosed in Bailey to obtain the process of claim 48. Thus, Applicants contend that there is no basis, absent the impermissible use of hindsight based on Applicants' own disclosure, for combining the references as suggested in the Official Action.

For at least the above reasons, claim 48 is patentable over the asserted combination of references. Because the remaining claims (claims 23, 29-33, 37-40 and 42) depend, directly or indirectly, from claim 48, these claims are also patentable over the asserted combination for at least the reasons that claim 48 is patentable. Applicants respectfully request reconsideration and withdrawal of the § 103(a) rejection over Ona in view of Bailey.

Claims 23 and 42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Ona in view of Bailey and further in view of Togashi (U.S. Patent No. 5,232,959). For at least the reasons that follow, withdrawal of the rejection is in order.

Claims 23 and 42 depend directly or indirectly from claim 48, and, therefore, necessarily include all of the features of claim 48. Accordingly, these claims are patentable over the combination of Ona in view of Bailey for at least the reasons explained above in response to the § 103 rejection over the combination of these references.

Furthermore, Togashi fails to overcome the above-deficiencies of Ona in view of Bailey. Specifically, the combination of Ona in view of Bailey and further in view of Togashi does not disclose or suggest all of the features of claim 48, and does not reflect a proper consideration of "all words" in claim 48.

Additionally, the rejection under section 103 over Ona in view of Bailey and further in view Togashi fails to consider the invention as a whole because the asserted combination does not disclose or fairly suggest a process that includes hydrosilylating polyorganohydrosiloxane with synthons having the formulae specified in claim 48 to prepare a nonturbid, functionalized silicone oil. Because the asserted

combination of references fails to consider the problem of producing a non-turbid, functionalized silicone oil of stable viscosity, Applicants submit that the process of claim 48 and, therefore, the processes of claims 23 and 42, which depend from claim 48, would not have been obvious over the asserted combination for at least this additional reason.

Furthermore, the combination of Ona, Bailey and Togashi also does not provide the requisite motivation for making the specific selection of components and variables and combining those selected components and variables with the teachings of Bailey and Togashi to arrive at the process of claim 48, from which Claims 23 and 42 depend. Again, the mere fact that the prior art can be modified does not make the modification obvious unless the prior art suggests the desirability of the particular modification. In re Gordon, *Id.* at 1127. Here, there is no intrinsic basis in the prior art references themselves or any extrinsic factor that would prompt one of ordinary skill in the art to make the specific selection of variables and components from Ona combine those variables and components with a particular process among many disclosed in Bailey, and further combine those features with the teachings of Togashi to arrive at the processes of claims 23 and 42, as asserted. Applicants believe that any motivation for making this particular selection and combination can only come from the teachings of the present specification, which teaches the desirability of the claimed process for purposes of obtaining a non-turbid, functionalized silicone oil of stable viscosity. However, the teaching, suggestion or motivation for combining cited references "cannot come from the Applicants' invention itself." In re Oetiker, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). Again, the motivation for combining the references cannot be a product

of hindsight reconstruction of the claimed invention based on Applicants' own disclosure.

For at least the above reasons, claims 23 and 42 are patentable over the asserted combination. Applicants respectfully request reconsideration and withdrawal of the section 103(a) rejection over Ona in view of Bailey and further in view of Togashi.

Claims 37 and 38 stand rejected under 35 U.S.C. §102(e) as being anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over Crivello (U.S. Patent No. 6,124,418). For at least the reasons that follow, withdrawal of the rejection is in order.

The Official Action asserts that while Crivello does not teach the process of claim 48, the silicone oils prepared by Crivello and instant process claim 48 "appear" to be inherently the same. The Official Action further asserts that Crivello teaches a process for preparing an anti-adhesion product and a coating and, thus, concludes that Crivello teaches a process meeting that in claims 37 and 38 "but with the exception that the silicone oil is not made by the process of claim 48."

First, because claims 37 and 38 are clearly dependent on claim 48, they necessarily include all of the features of claim 48. Moreover in view of the above amendments to these claims, Applicants submit that it is clear that the processes claimed comprise silicone oils prepared in accordance with the process defined in claim 48. Because the Official Action states that Crivello does not include a silicone oil made by the process of claim 48, the processes of claims 37 and 38 are neither anticipated by nor rendered obvious over Crivello. That is, neither anticipation nor obviousness can be established because the Official Action admits that the cited

reference fails to disclose one of the claim features (i.e., a silicone oil made by the process of Claim 48).

In order for prior art to anticipate a claimed invention on the ground that a limitation is inherently disclosed in the reference, the inherency must be certain. (Emphasis added.) The fact that a prior art reference may have the characteristics of the claimed product is not sufficient. (Emphasis added.) Inherency must be a necessary result and not merely a possible result; the mere fact that a certain thing may result from a given set of circumstances is not enough". (Emphasis added.) See In re Oelrich, 666 F.2d 578, 581, 212 USPQ 323, 326 (CCPA 1981); Ex parte Keith and Turnquest, 154 USPQ 320, 321 (Pat. Off. Bd. App. 196). Accordingly, the Examiner must provide some evidence or scientific reasoning to establish the reasonableness of the belief that the limitation is an inherent characteristic of the prior art. See Ex parte Skinner, 2 USPQ2d 1788, 1789 (Bd. Pat. App. & Int. 1986). Certainly, the Official Action's own language that "...since the oils appear to be inherently the same, the processes claimed and the prior art processes appear to be inherently the same," indicates that the Official Action's assertion of inherency is not a necessary result but is recognized as merely a possible result. (Emphasis added.) As explained above, however, the mere fact that a certain thing may result is not sufficient to support an inherent anticipation rejection. (Emphasis added.)

With respect to the inherent obviousness rejection, Applicants submit that the Official Action fails to establish that the process of Crivello would "inherently" be the same as the processes claimed in claims 37 and 38. In order to establish a *prima facie* case, it is incumbent on the Patent Office to establish the asserted inherency. See In re King, 231 USPQ 136 (Fed. Cir. 1986). The Official Action must provide a

basis in fact or technical reasoning to reasonably support the assertions that the allegedly inherent characteristics of the Crivello process necessarily flow from the teachings of Crivello. (Emphasis added.) See Ex parte Levy, 17 USPQ2d 1461, 1464 (Pat. Bd. App. & Int. 1990).

Absent any additional teaching that establishes that the Crivello process does necessarily include the features of the claimed processes, the Official Action has failed to establish the asserted inherent features of the Crivello process. (Emphasis added.) Moreover, any such additional teaching relied on for the purpose of establishing inherency of the Crivello process, "must make clear that the missing descriptive matter is necessarily present in the thing [the Crivello process] described in the reference, and that it would have been so recognized by persons of ordinary skill in the art." (Emphasis added.) See Continental Can Co. v. Monsanto Co., 20 USPQ2d 1746, 1749 (Fed. Cir. 1991). The Official Action fails to provide any such additional teaching. In fact, the language "since the oils appear to be inherently the same, the processes claimed and the prior art processes appear to be inherently the same," on page 5 of the Official Action, provides clear evidence that the Patent Office does not believe that the Crivello process necessarily includes the features of the claimed processes.

For at least the above reasons, Applicants respectfully request reconsideration and withdrawal of the inherent anticipation and obviousness rejections of claims 37 and 38 over Crivello.

Claims 23, 29-33, 37-40, 42 and 48 stand rejected under the judicially-created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 6,545,115 and provisionally rejected under the doctrine of

obviousness-type double patenting over claims 1-14 of copending application 10/933,542. Again, Applicants request that the obviousness-type double patenting rejections be held in abeyance until an indication of allowable subject matter has been made. At that time, Applicants will evaluate the obviousness-type double patenting rejections to determine if a response is needed.

Finally, Applicants have added new claim 49 to further define an exemplary embodiment. Applicants respectfully submit that the exemplary embodiment defined in new claim 49 is patentable over the cited references for at least the reasons that claim 48 is patentable. Applicants respectfully request allowance of new claim 49 together with the remaining outstanding claims.

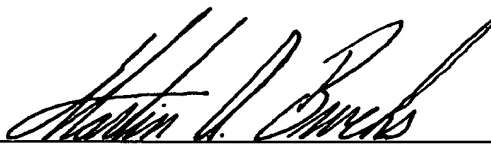
From the foregoing, Applicants earnestly solicit further and favorable action in the form of a Notice of Allowance.

If there are any questions concerning this paper or the application in general, Applicants invite the Examiner to telephone the undersigned at the Examiner's earliest convenience.

Respectfully submitted,

BURNS, DOANE, SWECKER & MATHIS, L.L.P.

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By: 
Martin A. Bruehs
Registration No. 45,635

P.O. Box 1404
Alexandria, Virginia 22313-1404
(703) 836-6620